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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/580,221	05/26/2000	Sung-Soo Lee	P56056	8252

8439 7590 09/09/2005

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EXAMINER
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PARK, CHAN S

ART UNIT	PAPER NUMBER
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2622

DATE MAILED: 09/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action  
Before the Filing of an Appeal Brief**

Application No.

09/580,221

Applicant(s)

LEE, SUNG-SOO

Examiner

CHAN S. PARK

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**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 24 August 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.  
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_.  
Claim(s) objected to: \_\_\_\_\_.  
Claim(s) rejected: 1-20.  
Claim(s) withdrawn from consideration: \_\_\_\_\_.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: \_\_\_\_\_  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). \_\_\_\_\_  
13. ☐ Other: \_\_\_\_\_.

  
EDWARD COLES  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600

***Advisory Action***

1. The period for reply continues to run 6 MONTHS from the date of the final rejection. Any extension of time must be obtained by filing a petition under 37 CFR 1.136(a) accompanied by the appropriate fee. The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. A reply within the meaning of 37 CFR 1.113 or a request for a continued examination (RCE) in compliance with 37 CFR 1.114 must be timely filed to avoid abandonment of this application.

***Response to Amendment***

2. Applicant's arguments, see page 11, with respect to the Drawings Objection have been fully considered and are persuasive. The objection of drawings has been withdrawn.
3. Applicant's arguments, see page 12, with respect to the Claim Objection have been fully considered and are persuasive. The objection of claim 1 has been withdrawn.
4. Applicant's arguments, see pages 12-14, with respect to the Claim Rejections under 35 U.S.C. § 112 have been fully considered and are persuasive. The rejections of claims 18 and 20 have been withdrawn. However, based on the applicant's arguments, the applicant's proper terminology "further comprised" should be also used for claim 18.

5. The amendment filed 8/18/05 under 37 CFR 1.116 in reply to the final rejection has been considered but is not deemed to place the application in condition for allowance and will not be entered because:

- a. Applicant's arguments have been fully considered but they are not persuasive.

With respect to claim 1, the applicant explains how the current invention differs from the teaching of Yoshida. Particularly, the applicant states that Yoshida fails to disclose the step of requiring and receiving said data output order by said facsimile transmitting part from said facsimile receiving part after rather, Yoshida only teaches a step of discriminating whether or not the partner station has both-side transmission function based on the signal received by the receiving facsimile. However, examiner notes that the designation of the both-side transmission or the one-side transmission directly constitutes the data output order of the facsimile receiving part because (1) each page received at the NCU of the receiving facsimile is outputted to the memory CKT 18 (col. 3, lines 7-9) in the order the data was received and (2) the invention of Yoshida suggests that the fax data which was received first will be printed first. Referring to the Background and Summary of the Invention, it is evidently clear that the invention deals with the facsimile transmission where no sorting is necessary at the facsimile receiving part. Thus, the fax data is outputted by the receiving facsimile in the same order which it was transmitted.

With respect to claim 6, the applicants states "it [is] not clear that requiring of said document order being made during Phase B of a facsimile transmission as figure 10

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shows the DIS, DTC and DCS signals regarding the transmission.” It is noted that the DIS signal notifies the output order (the presence or absence of the both-side reception) to the facsimile transmitting part (col. 3, lines 38-40 and fig. 10). As acknowledged by the applicant (fig. 3 of the Drawings), the Phase B includes the transmission of the DIS signal to the transmitting part.

With respect to claim 7, Yoshida teaches that method for dialing a predetermined number of the said facsimile receiving part is automatic. It is noted that when calling CKT 26 dials the destination number, it dials the number by itself upon receiving a call command pulse (col. 3, lines 22-25 & S84 in fig. 5). Thus, the previous rejection was not based on the probabilities or possibilities.

With respect to claim 2, the applicant states “Ishizuka only displays whether a destination unit is capable of dual sided reading or recording function only. The actual data order received is never displayed. Only the capability is displayed and even then its only if whether the part is capable of dual side only.” Examiner disagrees. As set forth above, the designation of the both-side transmission or the one-side transmission directly constitutes the data output order of the facsimile receiving part. Further, Ishizuka teaches the method for inquiring and displaying whether or not the destination apparatus is set in a mode for executing the dual-side processing (col. 7, lines 36-52). Thus, inquiring and displaying the mode in which the destination apparatus is set directly constitutes the displaying of the data output order as it is required for claim 2. That is, it displays whether the facsimile data will be printed/outputted in the dual-side or the single-side mode.

With respect to claims 4 and 11, the applicant states "figures 12-15 do not show that the data output order that is actually received in the receiving part is sent a predetermined bit of data, but only a capability of the receiving part is sent." Again, as set forth above, the capability, the designation of the both-side transmission or the one-side transmission, of the receiving part, directly constitutes the data output order.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation/suggestion for combining is clearly taught in the reference of Ishizuka. Ishizuka recognizes that the non-standard mode provides a simple way of indicating the presence of the dual-side recording function and the single-side recording mode (col. 8, lines 10-17). Thus, the suggestion/motivation for combining the non-standard mode of Ishizuka with the facsimile transmission of Yoshida would have been to provide a simple way of indicating the presence of the dual-side recording function and the single-side recording mode.

With respect to claim 8, arguments analogous to those presented for claims 1 and 2, are applicable.

With respect to claim 9, arguments analogous to those presented for claim 7, are applicable.

With respect to claim 18, the applicant states that "looking at cols. 7-8 [of Ishizuka], no such advanced transmitting function is actually selected to accommodate the requiring of the data output order." Examiner disagrees. It is noted that the inquiry key 220 is selected for requiring of the data output order (col. 7, lines 36-42). Examiner finds no apparent differences between the invention of Ishisuka and the advance-transmitting function of the applicant's claim/Specification. The applicant fails to specifically point out the differences from the claim/Specification to support the arguments.

With respect to claim 19, as set forth above, by displaying the capability/mode of the facsimile receiving part, it displays the data output order. That is, it displays whether the facsimile data will be printed/outputted in the dual-side or the single-side mode.

With respect to claim 20, as set forth above, by displaying the capability/mode of the facsimile receiving part, it displays the data output order. That is, it displays whether the facsimile data will be printed/outputted in the dual-side or the single-side mode.

With respect to claim 13, arguments analogous to those presented for claims 1 and 2, are applicable. Further, as noted above, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in *the knowledge generally available to one of ordinary skill in the art*. Therefore, the

suggestion/motivation for incorporating the tip and ring capabilities of Bloom into the facsimile transmission system of Yoshida would have been to provide the dial tone that can be managed in the telephone network system and to conform to the telephone exchange system.

With respect to claim 14, as recognized by the applicant, arguments analogous to those presented for claim 3, are applicable. As presented in the previous Office Action, it would have been obvious to one of ordinary skill in the art to incorporate the requiring and receiving said data output order, wherein said data output order being either a face down way or a face up way, of Suzuki into the facsimile method of requiring and receiving said data output order of the combined references. The suggestion/motivation for doing so would have been to eliminate the need of reorganizing the received document pages at the receiver side (page 7 of Suzuki).

#### **Applicant's arguments regarding the Finality**

The applicant states that the new grounds for rejection were not necessitated by the amendments. However, this is not correct. As seen in claim 1 for example, the applicant clearly added new limitations and changed the scope of the claim. As amended, the claim now recites "transmitting by said facsimile transmitting part, said stored document data according to said received data output order." Further, "a facsimile of a transmitting part" and "a facsimile of a receiving part" have been amended as "a facsimile of a transmitting part" and "a facsimile of a receiving part" respectively. It is apparent that the amendment to the claim makes a vast difference in the scope of the



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claim. While the term "a facsimile of a transmitting part" can be interpreted to include two different entities, the term "a facsimile transmitting part" limits the scope of the claim to only one entity. As the applicant correctly pointed out in the Remark filed on 8/18/05, wherein on page 15, lines 1-3, "[a]ll words in a claim must be considered in judging the patentability of the claim against the prior art." At this time, is the applicant is stating that the words "of a" should not have been considered by the Office at all? Based on the reason above, the new grounds for rejection were clearly necessitated by the amendments.

Although the amendments might have clarified the claims that the applicant once believed unclear, it is evidently clear that all amended claims required new grounds of rejections by the reasons stated above. Thus, the applicant's statement, "the amendment was only done for clarification reasons", should not be used as an excuse to withdraw the finality. It should not be intended to help the applicant to avoid receiving finality of the prosecution.

### ***Conclusion***


6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHAN S. PARK whose telephone number is (571) 272-7409. The examiner can normally be reached on M-F 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles can be reached on (571) 272-7402. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

csp  
September 2, 2005

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